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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,903	07/10/2003	Takehiro Yamakawa	D-1503	9577
32628 7590 05/02/2007 KANESAKA BERNER AND PARTNERS LLP 1700 DIAGONAL RD SUITE 310 ALEXANDRIA, VA 22314-2848			EXAMINER MCLEAN, NEIL R	
			ART UNIT 2609	PAPER NUMBER
			MAIL DATE 05/02/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/615,903	<b>Applicant(s)</b> YAMAKAWA, TAKEHIRO	
	<b>Examiner</b> Neil R. McLean	<b>Art Unit</b> 2609	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4-7, and 9-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Fujii et al. (US Patent 5,272,511).

Fujii et al. discloses an image forming apparatus comprising:

a. Regarding Claim 1:

a sheet feeding unit (100 in Figure 1) for feeding a sheet including a manuscript sheet (Column 3, lines 15-17) and an insert sheet (Column 2, line 66-Column 3, line 4) composed of a cover or an interleaf.

image reading means (Scanner Unit 104 in Figure 1) communicating with the sheet feeding unit for reading an image on the sheet fed from the sheet feeding unit;

an image forming unit (Photosensitive Drum 111 in Figure 1) electrically connected to the image reading means for forming the image read by the image reading means on a copy sheet; and

a sheet discharge unit (Trays 700 and 701 in Figure 1) for discharging the manuscript sheet, the copy sheet, and the insert sheet.

b. Regarding Claim 4:

An image forming apparatus according to claim 1, wherein said sheet discharge unit includes a copy sheet discharge unit (Trays 700 and 701 in Figure 1) for discharging the copy sheet with the image formed by the image forming unit, an insert sheet conveyance path (See Figure 3 for path(s)) for guiding the insert sheet fed from the sheet feeding unit to the copy sheet discharge unit, a manuscript sheet discharge unit (Trays 700 and 701 in Figure 1) for discharging the manuscript sheet fed from the sheet feeding unit, and a manuscript sheet conveyance path (See Figure 3 for path(s)) for guiding the manuscript sheet fed from the sheet feeding unit to the manuscript sheet discharge unit.

c. Regarding Claim 5:

An image forming apparatus according to claim 1, wherein said sheet discharge unit includes a copy sheet discharge unit for discharging the copy sheet with the image formed by the image forming unit, and a common conveyance path for guiding the manuscript sheet and the insert sheet fed from the sheet feeding unit to the copy sheet discharge unit (See Finisher Path 552 in Figure 3).

d. Regarding Claim 6:

An image forming apparatus according to claim 1, wherein said sheet feeding unit includes a sheet feeding tray (See Original Feeding Device 100 in Figure 1) for receiving the manuscript sheet and the insert sheet, and sheet separating means (Column 10, lines 39-43) for separating the manuscript sheet or the insert sheet one by one.

e. Regarding Claim 7:

An image forming system comprising: an attachment including a sheet feeding unit (100 in Figure 1) for feeding a manuscript sheet (Column 3, lines 15-17) and an insert sheet (Column 2, line 66-Column 3, line 4) and image reading means (Scanner Unit 104 in Figure 1) for reading an image on the manuscript sheet and the insert sheet fed from the sheet feeding unit; and an image forming apparatus main unit (Photosensitive Drum 111 in Figure 1) attached to the attachment and having image forming means for forming the image on a copy sheet.

f. Regarding Claim 9:

An image forming system according to claim 8, wherein said sheet determining means includes operation means for selecting the manuscript sheet and the insert sheet among the sheets fed from the sheet feeding unit (Column 12, lines 31-42).

g. Regarding Claim 10:

An image forming system according to claim 7, wherein said attachment includes a sheet discharge unit for discharging the copy sheet with the image formed by the image forming means (Trays 700 and 701 in Figure 1).

h. Regarding Claim 11:

An image forming system according to claim 7, wherein said attachment includes image data conversion means for reading the image on the manuscript sheet and converting the image into image data (See Block Diagram in Figure 2).

i. Regarding Claim 12:

An image forming system according to claim 7, wherein said attachment includes copy sheet feeding means for feeding the copy sheet to the image forming means (100 in Figure 1).

j. Regarding Claim 13:

An image forming system according to claim 7, wherein said sheet feeding unit includes a sheet feeding tray for receiving the manuscript sheet and the insert sheet, and sheet separating means (Column 10, lines 39-43) for separating the manuscript sheet or the insert sheet one by one (Trays 700 and 701 in Figure 1).

k. Regarding Claim 14:

An image forming system according to claim 7, wherein said attachment includes a copy sheet discharge unit (Trays 700 and 701 in Figure 1) for discharging the copy

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sheet with the image formed by the image forming means, an insert sheet conveyance path (See Figure 3 for path(s)) for guiding the insert sheet fed from the sheet feeding unit to the copy sheet discharge unit, a manuscript sheet discharge unit for discharging the manuscript sheet fed from the sheet feeding unit (Trays 700 and 701 in Figure 1), and a manuscript sheet conveyance path (See Figure 3 for path(s)) for guiding the manuscript sheet fed from the sheet feeding unit to the manuscript sheet discharge unit.

I. Regarding Claim 15:

An image forming system according to claim 7, wherein said attachment includes a copy sheet discharge unit (Trays 700 and 701 in Figure 1) for discharging the copy sheet with the image formed by the image forming means, and a common conveyance path (See Figure 3 for path(s)) for guiding the manuscript sheet and the insert sheet fed from the sheet feeding unit to the copy sheet discharge unit.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2,3, and 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii et al. in view of Koji (Japanese Publication Number 2000-165667).

- (i) Fujii et al. discloses all of the above except for being able to discriminate between the copy sheet and the insert sheet.
- (ii) In the same field of endeavor, Koji teaches an image forming device that can accurately discriminate an original type automatically by examining the spectral characteristics of the optical system of the scanner section.
- (iii) It would have been reasonable for one of ordinary skill in the art to incorporate the Koji's ability to differentiate between a copy sheet and a media sheet and combine it with the insert sheet transporting apparatus of Fujii et al.
- (iii) The motivation to do so would be to make a quick determination of media type without disturbing the user. This provides for a faster and more efficient system and increases the throughput and output of the image forming apparatus.

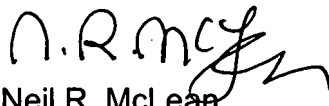
### ***Conclusion***

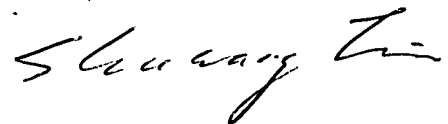
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Conrad et al. (US Patent 5,272,511) discloses a sheet inserter that inserts special insert sheets into a continuous stream of sheets by overlaying the insert sheets with a corresponding sheet in the continuous stream of sheets. The insert sheet overlaying the corresponding sheet in the continuous stream of sheets is then conveyed with the corresponding sheet to a final destination where the sheets can be compiled into a stack.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. McLean whose telephone number is 571.270.1679. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Liu Shuwang can be reached on 571.272.3036. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Neil R. McLean  
4/30/2007



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SUPERVISORY PATENT EXAMINER